

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-16 and 18-34.

The following claims are *independent*: 1, 33 and 34.

The following claims have previously been *cancelled* without prejudice or disclaimer: 17.

Please *amend* claims 1, 33 and 34; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-16 and 18-32 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the

aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.” Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature.

Although Applicant respectfully traverses the Examiner’s rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claim 1. Claim 1 recites, *inter alia*, “A computer-implemented method ... structuring via the computer system. . . calculating via the computer system. . . generating via the computer system . . .” As such, Applicant submits claim 1 (and as a consequence, claims depending therefrom) are transformative and/or specific structures directed to statutory subject matter for at least the reasons discussed above.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1-16 and 18-32 are allegedly directed to non-statutory subject matter. Accordingly, Applicant submits that claims 1-16 and 18-32 are directed to statutory subject matter, and respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claim(s) 1-16, 18-27, 30 and 32-34 under 35 U.S.C. § 102(e) as anticipated by Fogel, US Patent No. 6,542,905 (hereinafter “Fogel”). Applicant respectfully traverses the rejection and submits that a showing of anticipation has not been made and that Fogel does not discuss every element of the noted claim(s).

Requirements to Establish Anticipation

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As a consequence, has failed to establish a case of anticipation. 35 U.S.C. § 102.

Missing Claim Element(s)

Applicant submits Fogel does **not** discuss, and is in fact missing at least the following element(s) as recited, *inter alia*, in previously presented independent claim(s) 1, 33 and 34:

...
structur[ing] . . . the gathered data according to risk criteria and
the data relating details of the long term care transaction
...

The Office Action asserts that the previously pending elements are shown in Fogel (col. 5 lines 31-39 and col. 21 lines 11-36) and alleges:

Structuring the gathered data and the data relating details of the long term care transaction according to risk quotient criteria (column 5, lines 31-39 where the database provides structure and cloumn 21 lines 11-36); (Office Action, p. 5).

Applicant disagrees and submits the Office Action mischaracterized Fogel.

Contrary to the Office Action's assertions, Applicant submits that Fogel essentially discusses a *system for evaluating the integrity of pre-existing standardized data for use in the healthcare system* instead of the claimed "structur[ing] . . . the gathered data according to risk criteria and the data relating details of the long term care transaction," much less the amended claim that recites "structur[ing] . . . the gathered data according to risk criteria and the data relating details of the long term care transaction. . ." Applicant notes that Fogel discusses, "[a] set of tests for the integrity of [that pre-existing standardized] data. . . applicable to data sets with multiple assessments of the same person at different times." (Fogel, col. 21, lines 11-16). Applicant also notes that Fogel discusses, "The ability to perform automated data integrity audits is of particular value in industries subject to substantial regulation, in which the collection and transmission of [pre-existing] standardized data are mandated and required for funding, licenses, permits, determination of tax liability, etc." (Fogel, col. 21, lines 21-26).

Accordingly, Applicant submits that Fogel's *system for evaluating the integrity of pre-existing standardized data for use in the healthcare system* that employs the use of data structures is different from at least the claimed "structur[ing] . . . the gathered data according

to risk criteria and the data relating details of the long term care transaction,” as recited in claim(s) 1, 33 and 34. For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim element(s) and/or the applied reference and, thus, has not established a case of anticipation. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly anticipated by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference; more specifically, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes “Structuring the gathered data and the data relating details of the long term care transaction according to risk quotient criteria (column 5, lines 31-39 where the database provides structure and cloumn 21 lines 11-36),” described in Fogel, is allegedly analogous to and/or anticipates “structur[ing] . . . the gathered data according to risk criteria and the data relating details of the long term care transaction,” as recited in independent claim 1, 33 and 34.

Although of different scope than independent claim(s) 1, 33 and 34, Applicant submits claims 2-16, 18-27, 30 and 32 (and as a consequence any claims depending therefrom) are all patentable over Fogel for at least similar reasons as discussed above when identifying deficiencies in the Office Action’s application of Fogel with regard to independent claim 1, 33

and 34. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Fogel, and in view of Thompson, U.S. Pre-Grant Publication No 2002/0103834 (hereinafter “Thompson”). The Office Action also rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Fogel, and in further view of Guyan, U.S. Pre-Grant Publication No 2003/0145124 (hereinafter “Guyan”).

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements (A) and (B), and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, the claim element(s) recited in rejected claims 17, 28, 29 and 31:

...
structur[ing] . . . the gathered data according to risk criteria and
the data relating details of the long term care transaction
...

Applicant respectfully traverses the rejections and submits that the applied references taken alone or in combination, fail to discuss or render obvious every element of the claims and that a *prima facie* case of obviousness has not been established.

Instead of the Office Action's assertions, Applicant submits that dependent claims 17, 28, 29 and 31, which depend directly or indirectly from claim 1, are also patentably distinct from the applied references for at least similar reasons to those discussed above identifying deficiencies in Fogel with regard to independent claim 1. Applicant further submits that neither of Thompson's discussion that a "knowledge bank is a computerized repository of lexicons organized and stored in a hierarchical directory" (Thompson, para. 0014) nor Guyan's discussion that "[a] computer program is provided for developing component based software capable of handling insurance-related tasks" (Guyan, para. 0017) remedy the deficiencies of Fogel as discussed above with regard to independent claim 1. Accordingly, for at least these reasons, Applicant requests withdrawal of this ground of rejections.

As such, though of different scope than independent claim(s) 1, 33 and 34, Applicant submits dependent claims 17, 28, 29 and 31 (and as a consequence any claims depending therefrom) which depend directly or indirectly from independent claim 1 are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Fogel with regard to independent claims 1, 33 and 34. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result

in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-16 and 18-34, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209_336CP1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209_336CP1.

Respectfully submitted,
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